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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,155	11/19/2001	Jean Sini	19111.0059	8154

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EXAMINER

THAI, HANH B

ART UNIT	PAPER NUMBER
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2171

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DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/988,155

Applicant(s)

SINI, JEAN

Examiner

Hanh B Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This is in response to application filed November 19, 2001 in which claims 1-27 are presented for examination.

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-27 of the instant application is unpatentable under the judicially created doctrine of "obviousness-type" double patenting with respect to claim 1 of parent U.S. Patent No. 6,697,839.

Claims 1, 20 and 30 of US patent No. 6,697,839 contain every element of claims 1, 10 and 19 of the instant application and as such anticipate claims 1-27 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998)

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(affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 10 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Steed et al. (US Pub. No. 2002/0107755).

Regarding claims 1, 10 and 19, Steed discloses a method for automatically entering information into form fields (abstract of Steed) comprising the steps of:

- invoking a application program in response to an indication from a user of a mobile device to do so (see abstract and summary of Steed);
- scanning content transmitted from the application program to the mobile device to find a form having at least one field into which information is to entered (see [0012]; [0013]);
- retrieving and entering information to enter into the at least one field, if at last one mapping for the form exists (see [0023] to [0026] and [0044], Steed); and

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- transmitting the form including the entered information to the mobile device for display to the user ([0026] and [0043], Steed).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gershman et al. (US patent no. 6,401,085) in view of Steed et al. (US Pub no. 2002/0107755).

Regarding claims 1, 10 and 19, Gershman discloses a method for automatically entering information into form fields comprising the steps of:

- invoking a application program in response to an indication from a user of a mobile device to do so (see summary and col.2, lines 9-18, Gershman);
- scanning content transmitted from the application program to the mobile device (see col.2, line 66 to col. 3, line 9, Gershman);
- retrieving and entering information to enter into the at least one field (see col. 40, lines 28-54; Fig. 13 and corresponding text, Gershman); and
- transmitting the form including the entered information to the mobile device for display to the user (see Summary and col.37, line 59 to col.38, line10, Gershman).

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Gershman, however, does not disclose “a form including the entered information” and “the form having at least one field into which information is to enter, if at least one mapping for the form exists”. Steed, on the other hand, discloses a server-based electronic wallet system that the form is automatically filled data information at the proxy and delivered to the wireless device (see abstract; [0002]; [0003]; [0009] and [0012], Steed). Therefore, Steed discloses the claimed limitation of “automatically entering information into the form”. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gershman to include the claimed feature as taught by Steed. The motivation of doing so would have been to provide an urgent need for the consumer to request a remote server to fill up a form on his/her behalf (see [0007], Steed).

Regarding claims 2, 11 and 20, Gershman/Steed combination further discloses the receiving at least one edit made by the user of the mobile device of the entered information; and transmitting the form including the edited entered information to the application program (see [0013] and [0026], Steed). Further, it is inherent for a computer navigator to offer a user the ability to easily edit a display on screen. This ability has in large been the driving force behind the almost universal adoption of the computer as the preferred means of data entry via filling out a form.

Regarding claims 3, 12 and 21, Gershman/Steed combination further discloses the mapping for the form comprises information mapping at least one field of the form into which information is to be entered to stored information (see [0009], Steed).

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Regarding claims 4, 13 and 22, Gershman/Steed combination further discloses the creating information mapping at least one field of the form into which information is to be entered to stored information based on the received selection of information made by the user, if no mapping existed for the at least one field (see [0023], Steed).

Regarding claims 5, 14 and 23, Gershman/Steed combination further discloses the updating information mapping at least one field of the form into which information is to be entered to stored information based on the received selection of information made by the user, if the entered information was edited by the user (see [0021] and [0022], Steed).

Regarding claims 6, 15 and 24, Gershman/Steed combination further discloses the transmitting the form to the mobile device, if no mappings for the form exist; receiving at least one selection of information to be entered into the at least one field of the form into which information is to be entered made by the user of the mobile device; and transmitting the form including the selected information to the application program (see [0012] and [0013], Steed).

Regarding claims 7, 16 and 25, Gershman/Steed combination further discloses the creating information mapping at least one field of the form into which information is to be entered to stored information based on the received selection of information made by the user (see [0023], Steed).

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Regarding claims 8, 17 and 26, Gershman/Steed combination further discloses the transmitting the form to the mobile device, if no mappings for the form exist; receiving at least one selection of information to be entered into the at least one field of the form into which information is to be entered made by the user of the mobile device; and transmitting the form including the selected information to the application program (see [0012] and [0013], Steed).

Regarding claims 9, 18 and 27, Gershman/Steed combination further discloses the creating information mapping at least one field of the form into which information is to be entered to stored information based on the received selection of information made by the user (see [0023], Steed).

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Lee et al. (US 6,535,883) disclose a system and method for creating validation rules used to confirm input data.

2. Ndili et al. (US Pub 2001/0044849) disclose a system for providing network content to wireless devices.

3. Harrell et al. (US Pub 2002/0016727) disclose a systems and method for interactive innovation marketplace.

4. Black et al. (US 5,325,524) disclose locating mobile objects in a distributed computer system.



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5. Khalessi et al. (US 6,633,900) disclose a mobile crew management system for distributing work order assignments to mobile field crew units.

6. Kloba et al. (US 6,341,316) disclose a system program product for synchronizing content between a sever and a client based on state information.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh B Thai whose telephone number is 703-305-4883. The examiner can normally be reached on 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Hanh Thai *HT*  
Art Unit 2171  
April 14, 2004



**UYEN LE**  
**PRIMARY EXAMINER**